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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 586,937	06 02 2000	Jeffrey A. Hubbell	50154-003001	6551

7590 09 26 2002

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EXAMINER

RILEY, JEZIA

ART UNIT	PAPER NUMBER
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1637

13

DATE MAILED: 09/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/586,937

Applicant(s)

HUBBELL ET AL.

Examiner

Jezia Riley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Remarks

1. Applicants' arguments and amendments, filed on 8/12/02, have been approved and entered. They have been fully considered and they are deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either newly applied or reiterated. They constitute the complete set presently being applied to the instant application.

Specification

2. A substitute specification is required pursuant to 37 CFR 1.125(a) because the amendments to the specification filed 8/12/02 are too long (more than 20 pages) to be entered.

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

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under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 5-40 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Plate et al. (5,945,457).

Plate et al. discloses a hemocompatible composition comprising a polymer containing at least one pharmacologic material chemically bonded to a polymer backbone. Such compositions may be obtained by reacting a pharmacologic material with a compound containing a polymerizable group (e.g., an acyl halide) and thereafter either copolymerizing the acylated material with one or more copolymerizable monomers or first irradiating a backbone polymer and thereafter grafting the acylated pharmacologic material onto the irradiated polymer. The resulting products are hemocompatible and may be used in the manufacture of medical devices which come in contact with blood or other bodily fluids. The advantage of chemically bonded pharmacologic materials is that they are not leached out and retain their pharmaceutical effectiveness for a long period of time. The compositions may contain one or more additional pharmacologic materials which are physically admixed with polymers containing bonded pharmacologic materials.

The reference is directed to the preparation of either hydrophilic or hydrophobic polymer compositions that are hemocompatible. Such biologically active polymer

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compositions may be prepared from hydrophilic polymers, such as crosslinked hydrogel polymers, or from hydrophobic polymers. The biologically active materials, such as pharmacologic compounds which impart certain desired physiological properties to the polymer, may be incorporated by first functionalizing such pharmacologic compounds with a polymerizable group and then copolymerizing such functionalized compounds with monomer(s) that form hydrophilic polymers, or by grafting such functionalized compounds onto a preformed polymer.

The crosslinks can be covalent, ionic or hydrogen bonds with the polymer possessing the ability to swell in the presence of water containing fluids. Such crosslinkers and crosslinking reactions are known to those skilled in the art and in many cases are dependent upon the polymer system. Thus a crosslinked network may be formed by free radical copolymerization of unsaturated monomers. Polymeric hydrogels may also be formed by crosslinking preformed polymers by reacting functional groups found on the polymers such as alcohols, acids, amines with such groups as glyoxal, formaldehyde or glutaraldehyde, bis anhydrides and the like. As examples of introducing polymerizable groups one may react available amino, hydroxyl carboxyl and thiol groups from the pharmacologic material, with electrophiles containing unsaturated groups or by reacting a pharmacologic material with an unsaturated compound containing an electrophilic group capable of covalently reacting with hydroxyl, amino, carboxyl or thiol groups. For example, unsaturated monomers containing N-hydroxy succinimidyl groups, active carbonates such as p-nitrophenyl carbonate, trichlorophenyl carbonates, tresylate, oxycarbonylimidazoles, epoxide, isocyanates and aldehyde, and

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unsaturated carboxymethyl azides and unsaturated orthopyridyl-disulfide belong to this category of reagents. Illustrative examples of unsaturated reagents are allylglycidyl ether, allyl chloride, allylbromide, allyl iodide, acryloyl chloride, allyl isocyanate, allylsulfonyl chloride, maleic anhydride, copolymers of maleic anhydride and allyl ether and the like. Additionally, the modified hydrophilic polymers may also contain physically incorporated additional pharmaceutical materials which will gradually leach out of the modified polymer composition when in contact with a bodily fluid such as blood. A practical and convenient method is to dissolve one or more pharmaceutical materials in water and then immerse in this solution a hydrogel polymer that had been previously modified with a biologically active material. Depending on the amount of the pharmaceutical material that one wishes to physically incorporate, the modified polymer may be immersed in the pharmaceutical solution after drying or in a partially hydrated state and may remain in the solution from a few seconds to over a day or even more, but more usually from a few minutes to a few hours. Thereafter the polymer composition is further processed depending on the desired use. It may be first dried or formulated in its hydrated state to prepare a coating. Such methods are known to those skilled in the art.

Claims have added functions which the prior art has not analyzed; but given the above 102 rejection analysis substantiating the basic characterization of the composition of the invention being the same as the reference, these added characteristics are presumed to be inherent in the prior art composition.

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As it is pointed in *In re Fitzgerald* (205 USPQ), page 594, 2nd col., 1st full paragraph, supports the shifting of the burden of proof to the applicant that the instantly claimed invention is novel and unobvious over the prior art. Since both the prior art and the instant application prepare and use composition which appeared to be identical for therapy. The prior art therefore suggests the instant application under 35 U.S.C. § 103(a).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18, 23, and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 18, 23, and 29 are vague and indefinite because it is unclear what are the metes and bounds for the phrase "derivative thereof".

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jezia Riley whose telephone number is 703-305-6855. The examiner can normally be reached on 9:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 703-308-1119. The fax phone numbers

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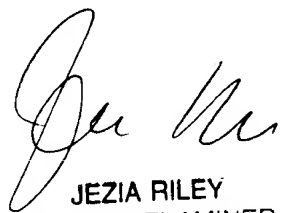
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for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Patent Analyst Monica Graves whose telephone number is 703-305-3002 or to the receptionist whose telephone number is 703-308-0196.

September 20, 2002


JEZIA RILEY
PRIMARY EXAMINER